

## **REMARKS**

The above amendments to the above-captioned application along with the following remarks are being submitted as a full and complete response to the Official Action dated July 9, 2004. In view of the above amendments and the following remarks, the Examiner is respectfully requested to give due reconsideration to this application, to indicate the allowability of the claims, and to pass this case to issue.

### **Status of the Claims**

Claims 1-19 are under consideration in this application. Claims 1, 5, 6, 9-10, and 13 are being amended, as set forth in the above marked-up presentation of the claim amendments, in order to more particularly define and distinctly claim applicant's invention. New claims 14-19 are being added to recite other embodiments described in the specification.

### **Additional Amendments**

The claims are being amended to correct formal errors and/or to better recite or describe the features of the present invention as claimed. All the amendments to the claims are supported by the specification. Applicant hereby submits that no new matter is being introduced into the application through the submission of this response.

### **Formality Rejection**

Figures 12 and 13 were objected as they should be labeled as "Prior Art," and the specification and claims 1-8 were objected to on various informalities. The Title of the Invention was objected to as being non-descriptive and the Examiner has requested correction thereof and a new title. As indicated, the specification, the drawings and the claims have been amended as required by the Examiner. Accordingly, the withdrawal of the outstanding formality rejection is in order, and is therefore respectfully solicited.

### **Allowable Subject Matters**

Claims 1-8 and 13 would be allowable if the informalities are corrected. As the informalities are being corrected as required by the Examiner, these claims are in condition for allowance.

**IN THE DRAWINGS:**

Please enter the attached corrected drawings Figs. 12-13, in which the legend "Prior Art" is being added, to replace Figs. 12-13 as originally filed. A Letter to Draftsperson is also submitted herewith.

### Prior Art Rejections

Claim 9 was rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 5,872,662 to Lee et al. (hereinafter “Lee”) as well as being anticipated by U.S. Pat. App. Pub. No. 2002/0118628 of Tachikawa et al. (hereinafter “Tachikawa”), and claims 10-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lee. The prior art reference of Leterme et al. (4,719,614) and Fujino (5,296,988) were cited as being pertinent to the present application. These rejections have been carefully considered, but are most respectfully traversed.

The optical pickup device of the invention (e.g., Fig. 2; p. 10, lines 15-19), as now recited in claim 10, comprises: a mounting frame; and a half mirror 5, wherein a mounting face 5B of said half mirror 5 is partially mounted onto a mounting face of said mounting frame with three adhesive contact points 13A, 13B, 13C fixing two parallel side faces 5C, 5D of said half mirror 5 to the mounting face of said mounting frame. As recited in claim 9 (Fig. 5; p. 12, lines 19-21), the adhesive contact points may substantially constitute a plane in parallel with the mounting face 5B of said half mirror 5. However, as shown in Figs. 6A-C, displacements may occur between a pair of sub-frames 11, 12 of the mounting frame.

The half mirror 5 is fixed at the three contact points constituting a mounting plane. Even if one of the sub-frames is displaced due to the influence of shrinkage and expansion of a half mirror and the mounting frames as shown in Figs. 6A-C, no twist will occur on the mounting plane, and the adhesive parts won’t flake off the sub-frames (p. 14, 1<sup>st</sup> paragraph). In the prior art, the half mirror 5 is fixed at the four contact points, if either one point is misaligned in height, the point will be displaced from the plane defined by the other three contact points (p. 13, last paragraph; Figs. 12-13).

Applicant respectfully contends that none of the above-mentioned prior art references teaches or suggests such “three adhesive contact points 13A, 13B, 13C fixing two parallel side faces 5C, 5D of said half mirror 5 to the mounting face of said mounting frame, while the half mirror 5 is partially mounted onto said mounting frame” according to the invention.

In contrast, the alleged half mirror 96 in Fig. 3 is not a half mirror, but a total reflection mirror (col. 8, line 29). On the other hand, a “*half mirror 93 has a size identical to the second slanted plate 94 and is attached to the upper surface of second slanted plate 94*” (col. 8, lines 22-24; Fig. 4) such that the half mirror 93 is completely (rather than partially) mounted on the slanted plate 94. Moreover, the pair of second protectors 95 are attached to both sides of the slanted plate 94 (rather than to any side faces of the half mirror 93) to

prevent the half mirror 93 from separating from the slanted plate 94 (col. 8, lines 24-27) such that there is simply NO (rather than three) adhesive contact point fixing two parallel side faces of the half mirror 93 to the mounting face of the slanted plate 94. It is well established that a rejection based on cited references that teach away from the invention is improper.

Tachikawa relies upon the fastening device 12 pressing against the top surface of the half mirror 3 to fix it therein ([0044],[0046]; Fig. 1). Tachikawa simply does not glue the side faces of the half mirror 3 to the pair of triangular plates 6 or any of the inner side surfaces 5a-d. As such, Tachikawa does have any adhesive contact points fixing two parallel side faces of said half mirror 3 to the mounting face of the triangular plates 6 as asserted by the Examiner. In particular, the prior art of Tachikawa (Fig. 9) merely puts the half mirror 3 on slope-like top surfaces 6a of both the triangular plates 6 such that ONLY the innermost end edge 3c of the half mirror 3 is made to abut against a slope-like abutting face 7 formed on the bottom end of one 5c of the remaining inner side surfaces 5c and 5d ([0005]). Tachikawa (Fig. 1) only pushes the half mirror 3 against the slope-like top surface 6a of the triangular plate 6 and fixed thereto in an inclined state by a pushing force P generated owing to the elastic deformation of the presser plate portions 12b ([0043]). In short, the side faces 3a-b of the half mirror 3 contact against the inner side surfaces 5a-b (Fig. 2), the side face 3d only has its edge line lying against the inner side surfaces 5d, and the side face 3c faces against the face 7. These contacting side FACEs or contacting side EDGEs do not constitute contacting POINTs. Nor do they constitute any adhesive contact points, since they are not glued to the inner side surfaces 5a-d or the like.

Further, contrary to the Examiner's assertion (p. 4, paragraph no. 9 of the outstanding office action), Applicant contends that three contact points for maintaining a stable connection of optical component is not obvious.

Although the invention applies the general mechanism of three contact points for maintaining a stable connection of optical component, the invention applies the mechanism between two parallel side faces of a half mirror and the mounting face of a mounting frame while the half mirror is partially mounted onto the mounting frame to achieve unexpected results or properties. For example, if one of the sub-frames is displaced as shown in Figs. 6A-C, no twist will occur on the mounting plane constituted by the three adhesive parts and the adhesive parts won't flake off the sub-frames. The presence of these unexpected properties is evidence of nonobviousness. MPEP§716.02(a).

*"Presence of a property not possessed by the prior art is evidence of nonobviousness. In re Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963) (rejection of claims to compound structurally similar to the prior art compound was reversed because claimed compound unexpectedly possessed anti-inflammatory properties not possessed by the prior art compound); Ex parte Thumm, 132 USPQ 66 (Bd. App. 1961) (Appellant showed that the claimed range of ethylene diamine was effective for the purpose of producing " 'regenerated cellulose consisting substantially entirely of skin' " whereas the prior art warned "this compound has 'practically no effect.' ").*

Applicant will point out that “[t]he submission of evidence that a new product possesses unexpected properties does not necessarily require a conclusion that the claimed invention is nonobvious. In re Payne, 606 F.2d 303, 203 USPQ 245 (CCPA 1979). See the discussion of latent properties and additional advantages in MPEP § 2145.” However, the unexpected properties were unknown and non-inherent functions in view of the prior art, since the prior art does not inherently achieve the same results. In other words, these advantages would not flow naturally from following the teachings of the prior art, since the prior art fails to suggest applying three adhesive contact points fixing two parallel side faces of a half mirror to the mounting face of a mounting frame while the half mirror is partially mounted onto the mounting frame.

Applicant further contends that the mere fact that one of skill in the art could rearrange the prior art to meet the terms of the claims is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for one skilled in the art to provide the unexpected properties, such as if one of the sub-frames is displaced due to the influence of shrinkage and expansion of a half mirror and the mounting frames, no twist will occur on the mounting plane constituted by the three adhesive parts and the adhesive parts won’t flake off the sub-frames, without the benefit of appellant’s specification, to make the necessary changes in the reference device. *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). MPEP§2144.04 VI C.

Applicant contends that neither Lee, Tachikawa, nor their combination teaches or discloses each and every feature of the present invention as disclosed in independent claims 9-10. As such, the present invention as now claimed is distinguishable and thereby allowable

over the rejections raised in the Office Action. The withdrawal of the outstanding prior art rejections is in order, and is respectfully solicited.

Conclusion

In view of all the above, clear and distinct differences as discussed exist between the present invention as now claimed and the prior art reference upon which the rejections in the Office Action rely, Applicant respectfully contends that the prior art references cannot anticipate the present invention or render the present invention obvious. Rather, the present invention as a whole is distinguishable, and thereby allowable over the prior art.

Favorable reconsideration of this application is respectfully solicited. Should there be any outstanding issues requiring discussion that would further the prosecution and allowance of the above-captioned application, the Examiner is invited to contact the Applicant's undersigned representative at the address and telephone number indicated below.

Respectfully submitted,

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